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NEW YORK, NY 10103-3198				
EXAMINER				
DANIELS, MATTHEW J				
ART UNIT		PAPER NUMBER		
1791				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,402

Applicant(s)

HORSTING ET AL.

Examiner

MATTHEW J. DANIELS

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 2/10/09

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 23-29** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **Claim 23** recites "a method matched to its composition" which is not described in the specification. "Dyed" layers are also not specifically disclosed. **Claim 27** also describes "cavity of the film generated by the deformation a fiber mat is placed" which is not described in the specification. **As to Claim 29**, the specification does not recite "special effect dyes."
2. **Claims 23-29** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claim 23** recites using "a method matched to its composition" which has no art-recognized meaning and is indefinite. Other claims are rejected by dependence. Additionally as to **Claim 29**, it is unclear what a special effect dye is if it is distinguishable from a dye without special effect.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 23-26 and 29** are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohrbacher (USPN 4959189). **As to Claim 23**, Rohrbacher teaches fabricating a structural using fiber-reinforced plastic material that may be deformed by thermal molding comprising: placing a plastic film (3:22) which contains a pigmented layer (interpreted to be a dye, see 2:60) onto a mold (Fig. 5, item 18) which displays the topography of the surface of the structural part (4:33-44), deforming the film in conformance with the surface of the structural part (Fig. 5, items 18-20), and subsequently applying a fiber-reinforced plastic material using a process capable of applying that composition onto the backside. The context of the claim does not require any particular order of steps, and therefore this claim is anticipated under 35 USC 102(b). In the alternative that the claims are meant to require that the deforming step be performed in the forming mold and that the fiber-reinforced plastic is subsequently applied also in the forming mold, then it is submitted that this is an obvious reordering of steps that would have been obvious to the ordinary artisan.

As to Claim 24, in the Rohrbacher process, Rohrbacher suggests that a preformed film (20) is placed onto a forming mold of a molding press (Fig. 5, item 21), wherein the fiber-reinforced plastic material is in the form of a mat placed on the counterpiece of the molding

press, and pressing to connect the pieces (Fig. 2, Fig. 5, arrow above 21). In the alternative, it would have been obvious to place the film on the other molding half in order to support the film prior to pressing it against the sheet molding compound. **As to Claims 25 and 26**, Rohrbacher provides a sheet molding compound (SMC, Abstract) which is either a thermosetting or thermoplastic material. **As to Claim 29**, Rohrbacher teaches that the transparent layer can be eliminated (6:30-35) and in doing so, suggests a pigmented or painted (dyed) top layer. The Examiner interprets this painted or finished surface to be a "special effect" dye since it colors the surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189) in view of Graefe (US 5,074,770). Rohrbacher teaches the subject matter of Claim 23 above under 35 USC 102(b), or in the alternative, under 35 USC 103(a). **As to Claim 27**, Rohrbacher teaches a preformed sheet inserted into a mold (Fig. 5), a fiber mat placed under the cavity of the film, and the mold is closed until a resin hardens (4:49-51). Rohrbacher is silent to the injection of the resin. However, in a first view this is merely a rearrangement of prior art process steps since Rohrbacher teaches applying resin to fibrous material before placing the fibrous material in the mold. However, one would have found it obvious to apply the resin to the

fibrous material at any point in the process. Additionally or alternatively, Graefe teaches a process in which a film is placed in a mold (Fig. 5, item 16), a fibrous layer is placed behind it (Fig. 5, item 30), and resin is injected after closing the mold (8:5-6). The injected resin contains a catalyst or initiator (13:10-15) which would act as a hardener when combined with the resin. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Graefe into that of Rohrbacher because (a) Rohrbacher clearly suggests that a combination of resin and fiber should be applied against the backside of a film, and Graefe provides a process for applying a resin and fiber material against the backside of a sheet, or (b) one of ordinary skill would have recognized the resin injection of Graefe as an obvious alternative or substitute for the use of a sheet molding material disclosed by Rohrbacher to provide the same result, namely a facing sheet with reinforced backing material.

5. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrbacher (USPN 4959189) in view of Furuya (US 6,150,026). Rohrbacher teaches the subject matter of Claim 23 above under 35 USC 102(b), or in the alternative, under 35 USC 103(a). **As to Claim 28**, Rohrbacher does teach a three layer film comprising a color layer (Fig. 2, 6:31-32), however, Rohrbacher is silent to coextrusion. Furuya teaches that it is known to provide a film useful in an exterior panel by coextrusion lamination (col. 12) before performing the skin and molding material against the back surface. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Furuya into that of Rohrbacher since one of ordinary skill would have recognized the Furuya coextrusion process as a

substitutable or alternative process for achieving or fabricating the film material to be preformed in the Rohrbacher process.

Response to Arguments

6. Applicant's arguments filed 10 February 2009 have been fully considered but they are not persuasive. The arguments are on the grounds that (a) Rohrbacher does not teach a dyed film, (b) Graefe discloses a film which is not dyed when it is back-injected, and (c) there is no evidence that Furuya can be used with Rohrbacher and Furuya does not provide a dyed film.

7. These arguments are not persuasive. Rohrbacher does provide a pigmented or colored film (for example, 6:32), and it is noted that the instant application does not actually disclose a “dyed” film. To the extent that Rohrbacher provides a pigmented or colored finish, it is interpreted to be the same as the claimed dyed film. Graefe likewise teaches a face sheet that comprises colorants and pigments (7:6). With respect to Furuya, it is submitted that Rohrbacher already requires a multilayer film, and there is no evidence that Rohrbacher provides a film which is distinguishable from a coextruded film. Note that the claim does not actually require a process of coextruding, and it is submitted that the structure of the Rohrbacher film would have been the same or substantially the same as the claimed “coextruded film.” Nevertheless, the Examiner maintains the position that even if the “coextruded” language is given weight, it would have been obvious to fabricate the film of Rohrbacher by a coextrusion process such as that of Furuya.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MATTHEW J. DANIELS** whose telephone number is (571)272-2450. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J. Daniels/
Primary Examiner, Art Unit 1791
6/4/09